

**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF APPEALS AND INTERFERENCES**

First Named Inventor : W. Daniel Hillis
Serial No. : 10/735,400
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Art Unit : 3714
Confirmation No. : 2127
Examiner : Paul D'Agostino
Title : VIDEO GAME CONTROLLER HUB WITH
CONTROL INPUT REDUCTION AND
COMBINATION
Attorney Docket No. : APPL0030

October 20, 2008

MAIL STOP: REPLY BRIEF - PATENTS

Honorable Commissioner of Patents & Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Appellant's Reply Brief follows.

STATUS OF CLAIMS

The status of the claims is as follows:

Claims 1-20 are rejected. Each of these claims is on appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following ground for rejection is to be reviewed on appeal:

1. Whether the subject matter of claims 1-20 is unpatentable under 35 USC §103(a) over Stiles (USPN 5,404,305) in view of Tanaka (US Pub. No. 2002/0072410).

ARGUMENTS

Tanaka Does Not Teach or Disclose a Reduced Set of Inputs or Collective Control

Claims 1-20 are rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,404,305 to Stiles in view of U.S. Patent Publication Number 2002/0072410 to Tanaka. In the Grounds of Rejection section of the Examiner's Answer, the Examiner asserts that the references support all the features disclosed in these claims.

Applicants respectfully disagree.

On page 5, paragraph 2, the Examiner cites Figure 12 "monitor device" and paragraph 163 of Tanaka for support that Tanaka teaches a "means of providing at least one reduced control input set to a video game console." However, Tanaka does not teach or suggest that the control inputs from the individual controllers are reduced in any way.

The "monitor device" is simply a display device, such as a television receiver, for depicting on-screen characters. Paragraph 163 simply states that the monitor device receives "video and audio signals." There is no indication in Tanaka of reducing signals in any way.

On page 5, paragraph 3, the Examiner cites paragraph 5 of Tanaka as evidence that Tanaka describes the features in claim 1 "wherein each reduced control input set determines an action of a separate on-screen entity said video game controllers collectively control at least one on-screen entity in order for the players to recognize which game characters are controlled by which controller so that the game can be enjoyed by a plurality of players." (emphasis added) Applicants respectfully point out that this statement is a contradiction. If the players are collectively controlling a character, there would be no reason to recognize which game characters are controlled by which controller. The Examiner's assertion only makes sense if each controller governs a separate character.

Furthermore, Tanaka fails to disclose these features. Paragraph 5 of Tanaka in its entirety reads: "The game will never proceed smoothly if the players cannot recognize by themselves that which game character is controlled by which controller, so that it is particularly important for such game that the correlation between the game characters and the controllers can be recognized by the players." Applicants cannot find any mention in this paragraph or anywhere else in the disclosure of a teaching or suggestion of a reduced control input set. This paragraph is referring to one player using one controller to control one game character. For a reduced control input set, on the other hand, multiple users use multiple controllers to control one player. Thus, Tanaka is not reducing control, but rather enhancing individual control through visual correlation of a controller with a character.

The Examiner also asserts that paragraph 5 of Tanaka supports the feature in claim 1 "wherein said video game controllers collectively control at least one on-screen entity." The Examiner characterizes this last feature as necessary to allow the players to recognize which game characters are controlled by which game controller." However, if the Examiner believes that Tanaka discloses a reduced control input set determining an action of a separate on-screen entity, and that the players are collectively controlling an on-screen entity, there would be no reason for the players to recognize which game characters are controlled by which game controller because they would all be controlling the same game character. Applicants have carefully reviewed the entire disclosure and find no teaching or suggestion of multiple players using multiple controllers to collectively control one game character. Thus, Tanaka fails to disclose this feature as recited in claim 1.

The Combination of Stiles and Tanaka Fails to Disclose Each and Every Feature of Claim 1

The combination of Stiles and Tanaka fails to teach or suggest “wherein each reduced control input set determines an action of a separate on-screen entity” or “wherein the video game controllers collectively control at least one on-screen entity.” Stiles merely discloses reduced-control input for a pilot and co-pilot controlling an aircraft. Abstract. Tanaka merely discloses an entertainment device with controllers that contain a display that allows players to correlate their controller with an individual on-screen character. See, for example, [0003] (“individually controlling such controllers”), [0004] (“correlation between individual characters appear on a television monitor and the individual controllers for operating such game characters”), [0005] (“which game character is controlled by which controller”), [0013] (“individual operators of the individual operation terminal devices can readily recognize the correlation between such individual operation terminal devices and information operable therethrough”), [0034] (“Contents to be displayed on the individual display portions **21A** and **21B** relate to correlation information expressing the correlation between the individual controllers and game characters”), *etc.*

In responding to Applicants’ argument on page 9, the Examiner again asserts that Tanaka teaches that players would know which characters they “individually and collectively control.” Applicants respectfully point out that Tanaka merely teaches individual control of a single game character. Nowhere in Tanaka is the concept of collective control disclosed. The concept of collective control is contrary to the teachings of Tanaka because the whole point of Tanaka is to provide a display on a controller for correlating the player with the game character. Having multiple people control one on-screen game character would make the display on the controller irrelevant.

Applicants provided a racing game example on page 3 of the Response filed November 21, 2007. Specifically: “if the hub was used to control an input set from five users playing a racing video game, a team of three could control the race car by averaging their inputs so

that if one user commanded rapid acceleration, another user commanded no acceleration, and a third user commanded mild acceleration, the resulting acceleration would be moderate.”

The Examiner uses Applicants’ example of a racing game to argue that the combination of Tanaka and Stiles describe all the features in claim 1. Specifically, the Examiner asserts that Stiles teaches that if two players controlled a racecar so that if one user commanded rapid acceleration and another user commanded no acceleration, the resulting acceleration would be moderate. The Examiner asserts that Tanaka teaches that the “players would know which on-screen racecars they can individually and collectively control because each racecar is identified.”

Using this example, however, there is no individual control of the racecar because both players are controlling the same car. Furthermore, there is no reason to correlate the controller with the on-screen entity because if there is only one racecar on the screen, it is obvious that each and every controller is controlling that racecar. Finally, if Stiles and Tanaka were combined to provide a racecar game, the players could still only control the racecar individually because both references fail to teach or disclose a reduced control input set that determines an action of a separate on-screen entity and video game controllers that collectively control an on-screen entity.

There is no Motivation to Combine Stiles and Tanaka

Assuming, *arguendo*, that the combination of Stiles and Tanaka discloses all the features as recited in claim 1, there is no motivation to combine Stiles and Tanaka because neither reference is improved by combining it with the other reference. “[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR v. Teleflex, Inc. et al.*, 82 USPQ.2d 1385 (2007).

Stiles describes collective control of a single aircraft. Tanaka describes enhancement of

individual control of an on-screen character. In Stiles, there is no need to identify which controller controls which aircraft, because there is only one aircraft to control. In Tanaka, the entire need to visually correlate the controllers with the on-screen entities arises only because there is more than one entity, with each controller governing a separate entity. Thus, there is no motivation to combine the two inventions.

The Examiner continues to confuse the issue regarding what each reference contains to bolster his argument. Stiles, for example, does not disclose “multiple entities” as the Examiner asserts on the last line of page 9. Stiles discloses two people controlling a single aircraft. Abstract

Lastly, the Examiner states on page 10 that “One skilled in the art would not look at Tanaka as narrowly as what is disclosed but broadly for all that it teaches.” Applicants submit that in order for a reference to teach something, it must disclose it. See, for example, *In re Royka*, 490 F.2d 981 (CCPA 1974) (“To establish a prima facie case of obviousness of a claimed invention, all the claimed features must be taught or suggested by the prior art.”) Thus, the Examiner cannot simply assert that the features recited in claim 1 that are not explicitly disclosed in Tanaka are somehow contained in a nebulous cloud of “teachings.” Applicants respectfully disagree with the Examiner’s assessment.

Because claim 11 is substantially similar to claim 1, it is patentable for at least the same reasons as claim 1. Additional limitations recited in the independent and dependent claims are not discussed further because the limitations discussed above are sufficient to distinguish the claimed invention from the cited art.

CONCLUSION

In view of the foregoing, and with reference to Appellant's brief and the record herein, Appellant respectfully submits that the Examiner is in error in regarding the cited references as teaching the claimed invention. At the very least, substantial elements of the claimed invention are not shown anywhere in any of the references, either alone or in combination. Further, there is nowhere a teaching or suggestion that the references could be combined. As such, there is nothing to motivate a person skilled in the art to combine the references as asserted by the Examiner.

Accordingly, Appellant respectfully requests that the Board favorably receive Appellant's remarks and reverse the Examiner's holdings.

The Commissioner is authorized to charge any additional fees or credit any overpayments to Glenn Patent Group Deposit Account 07-1445 (Order No.: APPL0030).

Respectfully submitted,



Elizabeth Ruzich

Registration No. 54,416

USPTO Customer 22,862